

Remarks

This Application has been carefully reviewed in light of the Office Action mailed December 31, 2007 ("Office Action"). Applicant respectfully provides the following remarks and respectfully requests reconsideration and allowance of all pending claims.

Interview Summary

Applicant appreciates the courtesy and opportunity to discuss this Application in the telephone interview with the Examiner on April 3, 2007. During the interview, Applicant highlighted one distinction between the pending claims and *Frazer*. Specifically, Applicant pointed out that *Frazer* fails to disclose at least a "second arch comprising an anterior bearing platform" that is "elongated in an anterior-posterior direction," as recited in Claim 1. The Examiner agreed that *Frazer* fails to disclose this element, but requested that Applicant reiterate this distinction in a written response. The requested response is provided below.

The Claims are Allowable Over *Frazer*

The Examiner rejects Claims 1-6 and 8 under 35 U.S.C. § 102(b) as anticipated by Canadian Patent No. 2,208,624 ("*Frazer*"). Applicant respectfully disagrees.

Claim 1 recites an oral appliance for maintaining stability of one or more aspects of a user's masticatory system that includes a "second arch comprising an anterior bearing platform" that is "elongated in an anterior-posterior direction." The Examiner cites to Figures 1 and 2 in *Frazer* and asserts that the anterior bearing platform is disclosed by element 12 in these figures. (Office Action, Page 2.) However, as acknowledged by the Examiner during the interview, these figures do not depict an anterior bearing platform that is "elongated in an anterior-posterior direction." *Frazer* describes element 12 as a "dome" which corresponds to its depiction in Figures 1 and 2. (Page 6, lines 36-39.) Accordingly, *Frazer* fails to disclose every element of Claim 1. Claim 1 is allowable for at least this reason.

Claims 2-6 and 8 are allowable at least because they depend from Claim 1, shown above to be allowable. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 1-6 and 8.

The Claims are Allowable Over the Proposed *Frazer-Uenishi* Combination

The Examiner rejects Claim 7 under 35 U.S.C. § 103(a) as unpatentable over *Frazer* in view of U.S. Patent No. 6,505,625 to Uenishi ("*Uenishi*"). Applicant respectfully disagrees.

Claim 7 depends from Claim 1. As discussed above with respect to Claim 1, *Frazer* does not disclose at least a "second arch comprising an anterior bearing platform" that is "elongated in an anterior-posterior direction." The proposed combination of *Uenishi* with *Frazer* fails to overcome these inadequacies. Moreover, the Office Action does not identify any portion of *Uenishi* as disclosing this element. Claim 7 is allowable for at least this reason.

In addition, the proposed *Frazer-Uenishi* combination is improper because both *Frazer* and *Uenishi* explicitly teach away from the proposed combination and contradict the rationale relied upon by the Examiner. The M.P.E.P. explicitly states, "If [the] proposed modification would render the prior art invention being modified *unsatisfactory for its intended purpose*, then there is *no suggestion or motivation to make the proposed modification*." M.P.E.P. § 2143.03, citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (emphasis added); see also *KSR*, 127 S.Ct at 1739 (when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious). Here, the Office Action states that it would have been obvious to further construct "the first and second arches disclosed by Frazer ... with more than planar region on the first arch and left and right bearing points on the other arch as taught by Uenishi." (Office Action, Page 3.) However, the express purpose of the device disclosed in *Uenishi* is to create an inconformity in the right and left occlusal heights. (See Column 5, Lines 3-5 and 29-31.) In order to achieve this purpose, *Uenishi* requires the use of "at least two projections." (Column 8, Lines 18-19.) If a single anterior bearing point was substituted for the "at least two projections" in *Uenishi*, as proposed by the Examiner, then there would be no contact on the left and right side of the jaw and the device could not fulfill the purpose of creating "an inconformity in the right and left occlusal heights." Accordingly, the modified device would be unsatisfactory for its intended purpose. Thus, the proposed combination of *Frazer* and *Uenishi* is improper and should not serve as the basis for a 35 U.S.C. § 103(a) rejection.

Claim 7 is allowable for at least these additional reasons. Applicant respectfully requests reconsideration and allowance of Claim 7.

The Double Patenting Rejection is Moot

The Examiner rejects Claims 1-40 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8-14, and 16-27 of U.S. Patent No. 6,886,566. The Examiner also provisionally rejects Claims 1-40 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-6, and 8-28 of copending Application No. 10/308,311. Applicant has submitted a Terminal Disclaimer to overcome both the rejection and the provisional rejection. Applicant respectfully requests the Examiner to withdraw this rejection and issue a notice of allowance for Claims 1-40.

CONCLUSION

Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Russ Crain, Attorney for Applicant at the Examiner's convenience at (214) 953-6803.

Applicant believes that no fee is due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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